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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.				
10/798,120	03/11/2004	Lawrence M. Janesky	257-011631-US(PAR)	8802				
2512 PERMAN & GREEN 425 POST ROAD FAIRFIELD, CT 06824	7590 04/09/2008		<table border="1"><tr><td>EXAMINER</td></tr><tr><td>GILBERT, WILLIAM V</td></tr></table>		EXAMINER	GILBERT, WILLIAM V		
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

### Office Action Summary

**Application No.**

10/798,120

**Applicant(s)**

JANESKY, LAWRENCE M.

**Examiner**

William V. Gilbert

**Art Unit**

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 28 January 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-6 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-6 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-946)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)  
Paper No(s)/Mail Date \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: \_\_\_\_\_

**DETAILED ACTION**

This is a First Action following a Request for Continued Examination. Claims 1-6 are pending.

***Continued Examination Under 37 CFR 1.114***

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 28 January 2008 has been entered.

***Drawings***

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the substantially continuous wall portion extending...into...substantially continuous contact with the supporting footing (Claim 1, line 14) must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

Corrected drawing sheets in compliance with 37 CFR 1.121(d) are required in reply to the Office action to avoid abandonment of the application. Any amended replacement drawing sheet should include all of the figures appearing on the immediate prior version of the sheet, even if only one figure is being amended. The figure or figure number of an amended drawing should not be labeled as "amended." If a drawing figure is to be canceled, the appropriate figure must be removed from the replacement sheet, and where necessary, the remaining figures must be renumbered and appropriate changes made to the brief description of the several views of the drawings for consistency. Additional replacement sheets may be necessary to show the renumbering of the remaining figures. Each drawing sheet submitted after the filing date of an application must be labeled in the top margin as either "Replacement Sheet" or "New Sheet" pursuant to 37 CFR 1.121(d). If the changes are not accepted by the examiner, the applicant will be notified and informed of any required corrective action in the next Office action. The objection to the drawings will not be held in abeyance.

***Claim Rejections - 35 USC § 112***

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

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The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**Claim 1** is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

In Claim 1, applicant claims the "substantially continuous wall portion extending outwardly from said upper panel section away from said wall and downwardly into substantially continuous contact with the supporting footing...", per lines 12-14. Based upon the disclosure (in particular figure 1,) it is unclear to the examiner how member portion 14 can be in substantial continuous contact with the footing while a gap (19) is present. Appropriate correction is required.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

**Claims 1-6** are rejected under 35 U.S.C. 103(a) as being unpatentable over Janesky (U.S. Patent No. 6,672,016).

Claim 1: Janesky discloses a drain panel assembly having a plastic drain panel (Fig. 2: generally: Abstract, line 5) having an upper panel section (13) extending vertically up from a lower skirt section (15), the upper section is adjacent a basement wall (11) and spaced by spacers (18), the lower skirt has a substantially continuous wall portion extending outwardly from the upper panel section away from the wall and is in substantially continuous contact with the footing section (via 20a as shown in applicant's drawings and specification; see "A" from attached Figure 2 from Jaenson below) so that an outer surface of the skirt faces away from the upper panel section to

form a longitudinal water conduit (15a, 23) extending along the length of the footing, the conduit being provided with a plurality of spaced drain openings (23) for draining water over the footing surface. While the Janesky reference discloses the wall portion extends continuously along a length of the footing, it does not disclose that extends along an entire length of the footing. It would have been obvious at the time the invention was made to a person having ordinary skill in the art as a matter of design choice to have the as claimed because applicant failed to state a criticality for the necessity of the limitation and the prior art of record is capable of being designed to meet the limitation as claimed. See MPEP 2144.04(IV) (A) citing *Gardner v. TEC Systems, Inc.*, 725 F.2d 1338 (Fed. Cir. 1984), the Federal Circuit held that, where the only difference between the prior art and the claims was a recitation of relative dimensions of the claimed device and a device having the claimed relative dimensions would not perform differently than the prior art device, the claimed device was not patentably distinct from the prior art device. Applicant should note that only the panel assembly is claimed. The phrases "adapted to control...supporting footing", lines 1-4, and "for draining...drain tile" lines 21, 22 are statements of intended use of the claimed invention and must result in a

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structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

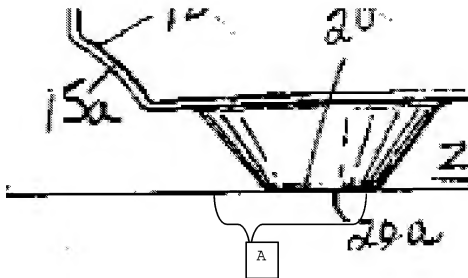


Figure 2 from Jaenson

Claim 2: the lower skirt section (15) has a cover means (14) for shielding each drain opening and the footing surface.

Claim 3: the cover means has spaced narrow shield strips (a strip is a row of depressions 20) of plastic that provide a passage between its underside and surface of the footing, the passage communicates between one of the drain openings and the edge of the footing.



Claim 4: the shield strip has a plurality of spaced depressions (20) extending to contact the footing and provide the water-flow passage, and the depressions are capable of receiving concrete.

Claim 5: the cover means is a shield strip having standoff ribs (bottom portion of well 17) that support the strip on the footing to provide a flow space between a drain opening and the edge of the footing.

Claim 6: the conduit (15a, 23) extends along a length of the footing and wall interface and is continuous without obstruction to flow of water along the length of the footing (see Fig. 3 where the water travels unobstructed through openings 15a, 23)

#### ***Response to Arguments***

5. The following addresses applicant's remarks dated 28 January 2008.

#### **35 USC §102(b) rejection:**

Applicant's arguments filed 28 January 2008 have been fully considered but they are not persuasive. Regarding the amendment to Claim 1, applicant's amendment and argument are not persuasive as the prior art of record reads on the limitations

as claimed (see rejection above.) Applicant claims that the limitations are drawn to a portion that is in substantial continuous contact with the supporting footing section; however, the drawings appear to fail to disclose this portion (see rejections above.) For the same reasoning, the examiner notes that the element in the Janesky (cited above) reference designated as 20a forms a "substantially continuous wall". As a result, in light of the specification and drawings, the examiner concludes that the prior art of record above reads on the claims as amended.

### ***Conclusion***

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to William V. Gilbert whose telephone number is 571.272.9055. The examiner can normally be reached on Monday - Friday, 08:00 to 17:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Richard Chilcot can be reached on 571.272.6777. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/W. V. G./  
Examiner, Art Unit 3635  
/Basil Katcheves/  
Primary Examiner, Art Unit 3635